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09/437,414	11/10/1999	ALEKSANDER SZLAM	CONCERTO-500AX	7944
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BOURQUE & ASSOCIATES INTELLECTUAL PROPERTY ATTORNEYS, P.A. 835 HANOVER STREET SUITE 301 MANCHESTER, NH 03104				
			EXAMINER	
			SING, SIMON P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**MAILED**

**AUG 11 2010**

**CENTRAL REEXAMINATION UNIT**

In re Reissue Application of	:	
Aleksander Szlam et al.	:	DECISION
Application No.: 09/437,414	:	TERMINATING
Filed: November 10, 1999	:	REISSUE PROCEEDING
Attorney Docket No.: CONCERTO-500AX	:	

This is a decision terminating the instant reissue proceeding based on the expiration of U.S. patent 5,214,688, for which patent the present application requests reissue.

**BACKGROUND**

1. Application number 07/533,489 ("489 application") was filed on June 5, 1990, pursuant to the provisions of 35 U.S.C. § 111.
2. The '489 application was allowed on December 29, 1992, and issued as U.S. Patent No. 5,214,688 ("688 patent") on May 25, 1993.
3. Neither the '489 application nor the resulting '688 patent claimed benefit of any earlier filed application or applications filed under 35 U.S.C. §§ 120, 121 or 365(c).
4. Reissue application No. 08/449,887 ("887 reissue application") was filed on May 25, 1995, for reissue of the '688 patent and issued as U.S. Patent No. Re. 36,416 on November 30, 1999.
5. Reissue application No. 09/437,414 ("414 reissue application") was filed on November 10, 1999, for reissue of the '688 patent, and it is a continuation of the '887 reissue application.
6. The Image File Wrapper (IFW) record for the '414 reissue application reveals that a paper titled "Amendment" was filed on June 25, 2010, and that the prosecution of the application is not closed.

**STATUTES AND PATENT EXAMINING PROCEDURES**

35 U.S.C. § 251, first paragraph, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. §§ 154(a)(2) and (a)(3) provide that:

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

35 U.S.C. § 154(c)(1) states:

DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

MPEP § 2701 states, in pertinent part,

All patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the "twenty-year term" or seventeen years from the patent grant. See 35 U.S.C. 154(c).

## DECISION

As pointed out above, the '688 patent issued from the '489 application. The '688 patent does not claim benefit under 35 U.S.C. §§ 120, 121 or 365(c) of any earlier filed application or applications. The '688 patent is a patent that was in force on June 8, 1995. Therefore, the term of the '688 patent is the greater of seventeen years from its issue date of May 25, 1993 or twenty years from the June 5, 1990 filing date of the '489 application that matured into the '688 patent. The '688 patent term, as calculated by using seventeen years from the issue date of May 25, 1993, extends through May 25, 2010. The '688 patent term, as calculated by using twenty years from the filing date of the '489 application, extends through June 5, 2010. In accordance with 35 U.S.C. § 154(c)(1) and the discussion in MPEP § 2701, the term of the '688 patent is the longer term, *i.e.*, twenty years measured from the June 5, 1990 filing date of the '489 application. Thus, the patent expired after June 5, 2010.

The United States Court of Appeals for the Federal Circuit has stated:

"[t]he language of [35 U.S.C. §] 251 is unambiguous: the [Director] has authority to reissue a patent only *for the unexpired term of the original patent.*" (Emphasis the Court's.)

*In re Morgan*, 990 F.2d 1230, 1231, 26 USPQ2d 1392, 1393 (Fed. Cir. 1993) (quoting 35 U.S.C. § 251, ¶ 1). Therefore, assuming (*arguendo*) that the conditions of 35 U.S.C. § 251 are otherwise satisfied, the USPTO Director has the authority to reissue the '688 patent only for a term that expires on June 5, 2010, in accordance with 35 U.S.C. § 251, ¶ 1 ("the Director shall . . . reissue the patent . . . for the unexpired part of the term of the original patent.")

Because the '688 patent is now an expired patent, the Director no longer has the authority under 35 U.S.C. § 251 to reissue the '688 patent. *In re Morgan*, 990 F.2d at 1231, 26 USPQ2d at 1393.

### CONCLUSION

1. In view of the above, the '414 reissue application is hereby terminated. See *Morgan*, 990 F.2d at 1232, 26 USPQ2d at 1393 (while 35 U.S.C. § 251 does not expressly require termination of a reissue proceeding when a patent expires, that is an inevitable concomitant of the provision that the patent can no longer be reissued).
2. This decision is not a final agency action within the meaning of 5 U.S.C. § 704. Any request for further review of this matter must be by way of a petition under 37 CFR 1.181(a)(3) filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b).
3. Jurisdiction over the '414 reissue application is being retained by the Office of Patent Legal Administration for the two months in which any request for further review may be submitted (plus time to match any such request). At that time, if no persuasive request is received, the application will be forwarded to Technology Center Art Unit 2614 for processing as an abandoned application.
4. Telephone inquiries concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Kenneth M. Schor  
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